

REMARKS

In the Office Action, the Examiner rejected claims 1, 3-9, 11-17, and 19-24, and objected to claims 2, 10, and 18. By this paper, Applicants have cancelled claim 19 and amended claims 1, 9, 17, and 21 for clarification of certain features to expedite allowance of the claims. No new matter has been added. Upon entry of these amendments, claims 1-18 and 20-24 are pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Allowable Subject Matter

In the Office Action, the Examiner stated that claims 2, 10, and 18 would be "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action, Page 5. Applicants would like to thank the Examiner for noting the potential allowability of these claims, but believe that based on the arguments and remarks set forth below, all of the pending claims are allowable in their present form.

Interview Summary

In accordance with 37 C.F.R. § 1.133 and M.P.E.P. § 713.04, Applicants present the following summary of a telephonic interview between the Examiner and the Applicants' Attorney, David M. Hoffman, Reg. No. 54,174. The interview was conducted on October 18, 2006.

The interview was initiated by Applicants' Attorney to discuss the pending Section 103 rejection and the Brown reference (U.S. Patent No. 6,397,287) as it relates to the independent claims in the present application. After discussing the Brown reference and the pending claims, the Examiner agreed to withdraw the pending Section 103 rejections based on the Brown reference in view of the amendments set forth above.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1, 3, 9, 11, 17, 20-22 and 24 as being unpatentable over Tavallaei et al. (U.S. Patent No. 5,907,689, hereafter referred to as "the Tavallaei reference") in view of Brown et al. (U.S. Patent No. 6,397,287, hereafter referred to as "the Brown reference"); and rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over the Tavallaei reference in view of the Brown reference as applied to claims 1, 9, 17, and 21 above, and further in view of Chin et al. (U.S. Patent No. 5,299,315, hereafter referred to as "the Chin reference"). Applicants respectfully traverse these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Independent Claims 1 and 21

Applicants respectfully assert that neither the Tavallaei reference nor the Brown reference, either alone or in combination, disclose every feature of independent claims 1 and 21. For example, independent claim 1, as amended, recites an “embedded bus master being adapted to take control of the communication bus …wherein taking control of the communication bus comprises *slowing a rate* of snooped data arrival at the FIFO *without diverting* the snooped data.” (Emphasis added). Independent claim 21, as amended, recites a “bus master configured to throttle the flow of snooped data … wherein throttling the flow of snooped data comprises *slowing a rate* of snooped data arrival to the queue *without diverting* the snooped data.” (Emphasis added).

In sharp contrast, neither the Tavallaei nor the Brown reference recite the above-quoted features. First, the Examiner conceded in the Office Action mailed on July 26, 2006, that “Tavallaei fails to teach an imbedded bus master that is … adapted to take control of the

communication bus.” Page 3, lines 6-10. As such, the Examiner relied upon the Brown reference to cure this deficiency. However, Applicants respectfully assert that the Brown reference does not teach or suggest the above recited features. Rather, the Brown reference is directed towards bus logic that *diverts* transactions to an expansion bus to prevent overruns or underruns of transmit and receive buffers. Brown, col. 6, line 66-col. 7, line 15. More specifically, the Brown reference discloses a dynamic bus request logic 21 that is configured to “request the expansion bus 22 during both transmit and receive operations such that the size of the transmit and receive buffers are optimally utilized without causing an undue number of underruns and overruns.” *Id.* As the above-quoted section shows, the Brown reference clearly discloses *diverting* transactions away from the transmit and receive buffers to another bus. *See id.* For at least this reason, the Brown reference cannot teach or suggest the above-recited claim features. Moreover, as stated above, the Examiner conceded these distinctions during the recent Examiner’s Interview. Accordingly, Applicants respectfully request withdrawal of the pending Section 103 rejections to independent claims 1 and 21 and allowance of these claims, as well as the claim that depend therefrom.

Independent Claims 9 and 17

Applicants also respectfully assert that neither the Tavallaei reference nor the Brown reference teach or suggest the features of independent claims 9 or 17. For example, independent claim 9, as amended, recites an “embedded bus master being adapted to take control of the communication bus … wherein taking control of the communication bus comprises *initiating a read transaction on the communication bus.*” (Emphasis added).

Independent claim 17, as amended, recites “preventing further transfers on the communication bus … wherein preventing further transfers of data comprises *initiating a read transaction on the communication bus.*” (Emphasis added).

As stated above, Applicants respectfully assert that neither of the cited references, alone or in combination, teach or suggest the above-quoted claim features. First, as noted above, the Examiner conceded in the most recent Office Action that the Tavallaei reference did not disclose these features and relied upon the Brown reference to cure this deficiency. Office Action, page 3. However, the Brown reference does not disclose the above-recited claim features. Rather, as explained in more detail above, the Brown reference merely discloses shifting transmit and receive operations to an expansion bus to avoid overruns and underruns in the transmit and receive buffers. Brown, col. 7, lines 1-16. As the Examiner conceded in the Examiner’s Interview, this shifting does not involve initiating a read transaction on the communication bus. For at least this reason, Applicants respectfully assert that neither the Tavallaei reference nor the Brown reference, either alone or in combination, teach or suggest the above-recited features of independent claims 9 and 17. Accordingly, Applicants respectfully request withdrawal of the pending Section 103 rejection and allowance of these claims and the claims that depend therefrom.

Dependent claim 23

As stated above, the Examiner rejected claim 23 as obvious over the Tavallaei reference in view of the Brown reference and further in view of the Chin reference.

Applicants respectfully submit that claim 23 is allowable based on its dependency on claim 21, because the Chin reference does not cure the deficiencies described above with regard to the Tavallaei and Brown references. For at least this reason, claim 23 is believed to be allowable over the cited references taken alone or in conjunction with each other. Thus, Applicants respectfully request withdrawal of the rejection of claim 23.

Conclusion

Applicants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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